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EXAMINER

COSIMANO, EDWARD R

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/676,805

Applicant(s)

STONOH A ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) see box 6 below is/are pending in the application.
 4a) Of the above claim(s) none is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1,5-7,10,14,15,19,23,24,28-31,33-35,37-42,44-46,48-53,55-57,59,60,70,72 and 73 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 02 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

1. Applicant's claim for the benefit of an earlier filing date under 35 U.S.C. § 119(e) is acknowledged.
2. The set of drawings filed 02 March 2005 containing the approved proposed drawing corrections filed 16 October 2003 and 19 March 2004 and 30 August 2004 have been approved by the examiner.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. Claims 6, 15, 23, 24, 70, 72 & 73 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - 4.1 Claims 6, 15 & 24 are confusing and unclear as to why the barcode would be suppressed, since each of the preambles of claims 1, 10 & 19 recites that the label includes a "barcode" and the body of claims 1, 10 & 19 recites a functional limitation that a "rotational orientation" is assigned to the "bar code" on the label.
 - 4.2 In regard to claim 23, the scope and meaning of claim 23 can not be determined since claim 23 depends from cancelled claim 20.
 - 4.3 Applicant's reference to the "ad hoc interface" of claims 70, 72 & 73, is confusing since it is noted that applicant has defined an "ad hoc job" in the paragraph located at page 8, lines 16-24, "Referring to FIG. 6, a display screen 90 is presented on display 46 when a user selects an ad hoc job for creating labels. An ad hoc job includes a variety of different labels that may or may not be related. For instance, an ad hoc job may include replacement labels for an existing set of labels. Some of these labels will bear no ordered sequential relation to other labels in the job. However, the ad hoc job is versatile enough to include a group of labels that have an ordered sequence." As can be seen in fig. 7, user interface 90 is also used when the labels of a non "ad hoc job" are to be designed. Therefore, since user interface 90 is used to designate one or more labels for any type of job regardless of whether the job is or is not a "ad

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hoc job”, it can not be seen how user interface 90 can be regarded as the “ad hoc interface” as recited in claims 70, 72 & 73.

4.4 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.1 Claims 28-31, 33-35, 37, 39-42, 44-46, 48, 50-53, 55-57, 59, 70, 72 & 73 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Drisko (4,718,784).

5.1.1 In regard to claims 28, 29, 33-35, 37, 39-40, 44-46, 48, 50-51, 55-57 & 59, Drisko ('784) discloses a computer implemented machine/process which under the control of an accessible operating program stored in a memory performs the function of permitting an user to design one or more labels and then designate which of the designed labels are to be printed as a single print job on an supply of labels stock containing label that are arranged in one or rows and columns. To this end, the machine/process of Drisko ('784) includes the user of a control processor, memory, display, input device and printer that cooperate to permit the user to enter information/data that would:

A) for each label to be designed to define/designate for each printable character position/location on each label being designed the one or more alphanumeric characters, for example, text and/or serial numbers, or graphics, for example, a barcode, that is to appear on the label at each of the printable position/location on the label;

B) for each printable character position/location on each label being designed to define/designate a customized pallet that would define/designate the font size to be used and whether the character is to appear using bold print for each printable character position/location, where the pallet; and

C) for each designed label by the user, to designate the quantity of labels to be printed in a print queue/job as well as the order/sequence in which the designated labels are to be printed in the print queue/job.

Based on the entered information, the user may preview the designed label including the relative positions of the alphanumeric/graphical content of the label on a display. Further, when the print queue/job is to be printed as indicated by an entry from the user, the designated labels would be printed beginning on a designated label, for example the first available label, on the label stock and then serially on each available label in the rows/columns of labels on the label stock.

5.1.2 It is noted that each printable character position/location of the machine/process of Drisko ('784) could be of any length, for example, one character or multiple characters.

5.1.3 In regard to claims 30, 31, 41, 42, 52 & 53, since one of ordinary skill at the time of the invention would have inherently recognized that:

- A) the character to be printed could be a "prefix"; or
- B) the character to be printed could be a "suffix";

relative to any of the other characters to be printed on a label as the meaning of the words "prefix" and "suffix" would be understood by one of ordinary skill.

5.1.4 In regard to the "ad-hoc interface" of claims 70, 72 & 73, it is noted that since the machine/process of Drisko ('784) requires an user interface for the user to designate both the content and which labels to be printed and in what sequence the labels are to be printed, it would have been inherent to one of ordinary skill at the time of the invention that the user interface of the machine/process of Drisko ('784) is and "ad-hoc" interface with in the meaning of this phrase as defined by applicant, see the paragraph located at page 8, lines 16-24, "Referring to FIG. 6, a display screen 90 is presented on display 46 when a user selects an ad hoc job for creating labels. An ad hoc job includes a variety of different labels that may or may not be related. For instance, an ad hoc job may include replacement labels for an existing set of labels. Some of these labels will bear no ordered sequential relation to other labels in the job. However, the ad hoc job is versatile enough to include a group of labels that have an ordered sequence." As can be seen in fig. 7, user interface 90 is also used when the labels of

a non “ad hoc job” are to be designed. Therefore, since user interface 90 is used to designate one or more labels for any type of job regardless of whether the job is or is not a “ad hoc job”,

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 38, 49 & 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drisko (4,718,784) as applied above to claims 28-31, 33-35, 37, 39-42, 44-46, 48, 50-53, 55-57, 59, 70, 72 & 73 and further in view of Benada et al (5,621,864).

6.1.1 In regard to claims 38, 49 & 60, although Drisko ('784) permits the user to place a label serial number on a label, the machine/process of Drisko ('784) does not save the last serial number used so that the next label to be designed that includes a label serial number would use the next available succeeding serial number. However, in the environment of designing and generating customized labels, Benada et al ('864) discloses a computer implemented machine/process which under the control of an accessible operating program stored in a memory performs the function of permitting an user to design one or more labels that are to be sequentially identified by a unique indicia. To this end, the machine/process of Benada et al ('864) as would be inherently recognized by one of ordinary skill at the time of the invention was made that Benada et al ('864) would include a system/process that would keep track of the last unique indicia in the sequence of unique indicium that has been used so

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that no two labels would be potentially confused with one another, since both labels would have the same unique identifier. Since the user of the machine/process of Drisko ('784) when assigning serial numbers to labels would not want to have two labels with the same serial number so as to cause confusion, it would have been obvious to one of ordinary skill at the time of the invention that the label generation machine/process of Drisko ('784) could be modified to keep track of what serial numbers have been used as taught by Benada et al ('864), so that no two labels produced by the machine/process of Drisko ('784) could be confused by using the same serial number.

6.2 Claims 1, 5, 6, 7, 10, 14, 15, 19, 23 & 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drisko (4,718,784) as applied above to claims 28-31, 33-35, 37, 39-42, 44-46, 48, 50-53, 55-57, 59, 70, 72 & 73 and further in view of Gombrich et al (4,623,418).

6.2.1 In regard to claims 1, 5, 10, 14, 19 & 23, Drisko ('784) does not disclose that the user may designate one of two or more rotational orientations for the barcode or barcodes that are to be printed on the label. However, in the environment of designing labels Gombrich et al ('418) a computer implemented machine/process which under the control of an accessible operating program stored in a memory performs the function of permitting an user to design one or more labels that include the ability of the user to designate that any part of the designated content of the label, for example, the barcode may be rotated by either 0 degrees or 90 degrees relative to the any other part of the content of the label so that all of the content of the label as designated by the user would appear on the printed label. Since the user of the machine/process of Drisko ('784) when assigning each part of the content of a label would not want to have one or more parts of the designated content to interfere with another part of the designated content, it would have been obvious to one of ordinary skill at the time of the invention that the label generation machine/process of Drisko ('784) could be modified to include the ability of rotating the designated content of any one or more of the printable positions/locations of the label so that all of the designated content may fit on the label without interfering with any other content as taught by Gombrich et al ('418).

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6.2.2 In regard to the suppression of claims 6, 7, 15 & 24, it is noted that if the user does not designate the content of any one or more of the printable positions/locations of the label in the machine/process of Drisko ('784), then it would have been obvious to one of ordinary skill at the time of the invention that the user's failure to designate the content any one or more of the printable positions/locations of the label generation machine/process of Drisko ('784) as modified by Gombrich et al ('418) would in fact be a suppression of the content of that printable position/location of the label.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

7.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Response to applicant's arguments.

8.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been overcome by applicant's last response.

9. The examiner has cited prior art of interest, for example:

A) Price et al (4,939,674) which discloses a label generation process/machine in which an user may designate the information that is to be placed on a label of arbitrary sized and the sequence in which designated ones of the labels will be printed on a supply of labels arranged in an array of rows and columns.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (571) 273-6802.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

05/21/05



Edward R. Cosimano
Primary Examiner A.U. 3639